REMARKS

In the Official Action dated July 3, 2006, Claims 11, 13 and 15 are pending and under consideration. Claims 11 and 15 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,268,398 to Ghosh et al. with evidence by Lang et al. (U.S. Patent Application Publication No.: US 2005/0064501). Claims 11, 13 and 15 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ghosh et al. in view of Thiam et al. (FEBS Letter, 459:285-90, 1999) with evidence by Lang et al.

This Response addresses each of the Examiner's rejections. Applicant therefore respectfully submits that the present application is in condition for allowance. Favorable consideration of all pending claims is therefore respectfully requested.

In the first instance, as argued in response to previous Office Action, Lang et al. is a U.S. national application under 35 U.S.C. 371 based on international application No. PCT/EP00/03578, which was filed on April 19, 2000 and based on a German application DE 199 17 990.5 filed on April 20, 1999. Thus, Lang et al. is not a proper reference under 35 U.S.C. §§ 102 and 103. Applicant observes that the Examiner no longer cites Lang et al. as a prior art reference under 35 U.S.C. § 102 or 103.

Claims 11 and 15 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by Ghosh et al. as evidenced by Lang et al. The Examiner states that Ghosh et al. teach a method of administering chelerythrine as a kinase inhibitor for therapy of certain diseases, such as Alzheimer's disease, diabetes mellitus, neuropathy, epilepsy, stroke and traumatic injury to brain. The Examiner appears to admit that Ghosh et al. do not teach a method of causing amnesia in an animal suffering from a pain syndrome. However, the

Examiner alleges that the above-listed diseases would have pain syndrome associated with the diseases and the administration of chelerythrine inherently has the amnesiac effect.

In the first instance, Applicant observes that Ghosh et al. is directed to compositions and methods for treatment of certain mitochondria-associated diseases such as cancer, psoriasis, stroke, Alzheimer's disease and diabetes. Nowhere do Ghosh et al. disclose a method of causing amnesia in an animal suffering from a pain syndrome.

Applicant respectfully submits that it is well settled that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Emphasis added). A 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to: (A) Prove the primary reference contains an "enabled disclosure;" (B) Explain the meaning of a term used in the primary reference; or (C) Show that a characteristic not disclosed in the reference is inherent. See MPEP 2131.01. In this case, the Examiner alleges that Lang et al. teach that the chelerythrine suppresses the activation of the Na+ channel. The Examiner also alleges that Lang et al. teach treatment of epileptic seizures with kinase inhibitors. The Examiner further alleges that Lang et al. teach diagnosing many diseases including those encompassed by the method of the present invention. Moreover, Applicant observes that Lang et al. related to h-sgk kinase or its inhibitors and does not related to a method of employing PKMζ inhibitors. Thus, Applicant respectfully submits that Lang et al. do not show that pain syndrome not disclosed in Ghosh et al. is inherent.

Accordingly, Applicant respectfully submits that nowhere do Ghosh et al. teach or suggest a method of causing amnesia or decreasing synaptic transmission in an animal suffering from a traumatic stress disorder, a phobia, or epilepsy by administering a PKMζ inhibitor to the animal. The Examiner fails to provide any objective evidence to show that the diseases treated by the method of Ghosh et al. inherently encompass pain syndrome.

Therefore, Ghosh et al., or Ghosh as evidenced by Lang et al., are not proper references under 35 U.S.C. 102. The rejection of Claims 11 and 15 under 35 U.S.C. §102(e) as allegedly anticipated by Ghosh et al. as evidenced by Lang et al. is overcome and withdrawal thereof is respectfully requested.

Claims 11, 13 and 15 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ghosh et al. in view of Thiam et al. (FEBS Letter, 459:285-90, 1999) as evidenced by Lang et al.

Applicant respectfully submits that Thiam et al. merely teach that the distribution of palmitoylated modified PKC-ζ pseudosubstrate lipopeptides is possibly correlated with a selective induction of apoptosis. Nowhere do Thiam et al. teach a method of causing amnesia or decreasing synaptic transmission by administering a therapeutically effective amount of a PKM-ζ inhibitor.

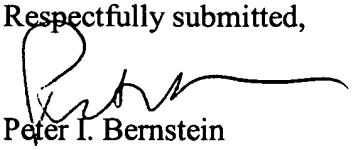
Applicant submits Ghosh et al. do not teach or suggest the method of the present invention as discussed above. Applicant respectfully submits that since Ghosh et al. with evidence by Lang et al. is not a proper reference under § 102, the rejection under

35 U.S.C. § 103 based on Ghosh et al. as evidenced by Lang et al. cannot be sustained. The combination of the cited art cannot achieve the present invention.

Therefore, the rejection of Claims 11 and 15 under 35 U.S.C. §103(a) as allegedly unpatentable over Ghosh et al. in view of Thiam et al. as evidenced by Lang et al. is overcome and withdrawal thereof is respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



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